SECTION III—REMARKS

This amendment is submitted in response to the Office Action mailed February 23, 2005. No claims are amended herein, and claims 1-32 remain pending in the application. Applicants respectfully request reconsideration of the application and allowance of all pending claims in view of the above amendments and the following remarks.

Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 1-32 under 35 U.S.C § 103(a) as obvious in view of, and therefore unpatentable over, different combinations of the following references: U.S. Patent No. 4,939,694 to Harrington *et al.* ("Harrington"); U.S. Patent No. 6,088,740 to Ghaffari *et al.* ("Ghaffari"); U.S. Patent No. 4,366,536 to Kohn ("Kohn"); and U.S. Patent No. 6,567,862 to Saito ("Saito").

Applicants respectfully traverse the Examiner's rejections. To establish a *prima facie* case of obviousness, three criteria must be met: (1) the prior art references must teach or suggest all the claim limitations; (2) some suggestion or motivation to combine the references must be found in the prior art; and (3) there must be a reasonable expectation of success. MPEP § 2143. Applicants respectfully submit that, as explained below, the Examiner has not established a *prima facie* case of obviousness.

Claims 1, 12, 23 and 28 are not obviated by Harrington

The Examiner rejected claims 1, 12, 23 and 28 as obvious in view of, and therefore unpatentable over, Harrington. Claim 1 recites a method combination including issuing a plurality of commands to a controller, wherein the commands are issued in a first order and "indicating the completion status of commands in a second order, wherein the second order is different from the first order." The Examiner alleges that Harrington:

[T]eaches the invention substantially as claimed, including a plurality of commands (col 2, ln 15-20), a controller (I/O controller, col 2, ln 15-20), issuing a plurality of commands to a controller, wherein the commands are issued in a first order (col 2, ln 15-20), the completion status of commands indicated in a second order (col. 2, ln 20-25), the term the second order is capable of being different from the first order (col 2, ln 22-25). Harrington does not explicit teach the term indicating. However, Harrington teaches notifying (col 4, ln 50-55).

Applicants respectfully disagree. First, the particular text of Harrington cited by the Examiner (col. 2, lines 20-25) does not teach that completion status of commands is indicated in a second order that is different from the first order. Instead, Harrington teaches only that commands or lists of commands received at a controller from a host processor can be *executed* by the controller in a different order than received (col. 2, lines 15-32). Harrington does not disclose, teach or suggest that completion notification is delivered in an order different than the order in which the commands were received, and therefore cannot disclose, teach or suggest every element of a combination including "indicating the completion status of commands in a second order, wherein the second order is different from the first order."

Second, the mere fact that a reference can be modified does not render the resulting modification obvious unless the prior art also suggests the desirability of the modification. *See* MPEP § 2143.01; *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). There is no teaching or suggestion in Harrington that any indication to the controller that commands have been executed should occur in any order other than the order in which the commands are issued, nor is there any teaching or suggestion in Harrington that such out-of-order notification is desirable. Any suggestion for the modification proposed by the Examiner, or the desirability of such a modification, can only have come from impermissible hindsight with the benefit of the present disclosure. Applicants submit

that claim 1 is therefore allowable and respectfully request withdrawal of the rejection and allowance of the claim.

Claim 12 recites an article of manufacture comprising a machine-readable medium having instructions stored thereon to issue a plurality of commands from a controller, wherein the commands are issued in a first order, and "indicate the completion status of commands in a second order, wherein the second order is different from the first order." By analogy to the discussion above for claim 1, Harrington does not disclose, and cannot teach or suggest, a combination including the recited limitations. Applicants submit that claim 12 is therefore allowable and respectfully request withdrawal of the rejection and allowance of the claim.

Claim 23, as amended, recites an apparatus including a controller adapted to accept a plurality of commands, wherein the commands are issued in a first order, and "wherein a completion status of each command is indicated in a second order, and wherein the second order is different from the first order." By analogy to the discussion above for claim 1, Harrington does not disclose, and cannot teach or suggest, a combination including the recited limitations. Applicants submit that claim 23 is therefore allowable and respectfully request withdrawal of the rejection and allowance of the claim.

Claim 28, as amended, recites a system including a controller adapted to accept a plurality of commands issued in a first order, a plurality of computational units to execute the plurality of commands, and a memory, "wherein a completion status of commands is written to the memory in a second order, and wherein the second order is different from the first order." By analogy to the discussion above for claim 1, Harrington does not disclose, and cannot teach or suggest, a combination including the recited limitations. Applicants submit that claim 28 is therefore allowable and respectfully request withdrawal of the rejection and allowance of the claim.

Claims 2-11, 13-22, 24-27 and 29-32 are not obviated by Harrington combined with Ghaffari, Kohn or Saito

If an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, independent claims 1, 12, 23 and 28 are in condition for allowance. Applicants therefore respectfully submit that claims 2-11, 13-22, 24-27 and 29-32 are allowable by virtue of their dependence on allowable independent claims, as well as by virtue of the features recited therein. Applicants therefore respectfully request withdrawal of the rejections and allowance of these claims.

Conclusion

Given the above amendments and accompanying remarks, all claims pending in the application are in condition for allowance. If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to allowance of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 292-8600.

Charge Deposit Account

Please charge our Deposit Account No. 02-2666 for any additional fee(s) that may be due in

this matter, and please credit the same deposit account for any overpayment.

Respectfully submitted,

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